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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/833,172	04/04/97	ROBL	HA830A

MW

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EXAMINER
BERCH, M

ART UNIT	PAPER NUMBER
1611	

DATE MAILED: 12/15/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/833,172**

Applicant(s)  
**Robl**

Examiner  
**Mark L. Berch**

Group Art Unit  
**1611**



☒ Responsive to communication(s) filed on 11/9/98

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 6-8, and 12-15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 6-8, and 12-14 is/are rejected.

☒ Claim(s) 15 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Claims 1, 7-8 and 12-14 are rejected as drawn to an improper markush group. The reasons were given previously. The first structure includes both 7 and 8 membered rings. Replacement of  $( )_{1,2}$  with  $\text{CH}_2$  will obviate the problem.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6-8 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. There still remains previous point 1. Applicants' traverse on this point is unpersuasive. The specific issues presented earlier have not been addressed. For example, applicants are invited to draw what they consider to be a heteroaryl group with 2 sulfur atoms.
2. There still remains previous point 2. Applicants' traverse on this point is unpersuasive. Does this mean e.g. cyclohexanone? That "includes" a heteroatom. A cycloalkyl cannot have a heteroatom, since by definition, a cycloalkane is a ring of the form  $(\text{CH}_2)_n$ .
3. There still remains previous point 3. Applicants' traverse on this point does not address the question. R is already bonded to the carbon to which it is attached. How

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can the monovalent R group form a ring in the first place? It would be helpful if applicants drew a structure with such a ring. The remarks say "the ring will be carbocyclic." On what basis? The claim language does not specify carbocyclic. If that is applicants' intention, the claims must so state.

4. On page 2, 8th from last line of Claim 1, there is a right parenthesis without a left one.

5. The second word in Claim 12 is misspelled.

The traverse of the requirement for restriction is unpersuasive. Of the material which applicants state that "Group II should include", the second structure is included. The first and 4th structures are included when  $Y = C$ , and, for the first one, when  $( )_{1,2}$  is  $CH_2$ . Otherwise, however, the fact that these are monocyclic is not sufficient. Rings such thiaazocines are clearly distinct from azepines in structure. Note, incidently, that Group V can be monocyclic as well. For example the 5-membered ring analog of the structure on page 62, line 1, item 4 would fall in group V.

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

A handwritten signature in black ink, appearing to read 'M Berch', is written above the printed name.

Mark L. Berch

Primary Examiner

Group 1610 - Art Unit 1611

December 8, 1998